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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/824,275 | 04/14/2004 | James P. Jones | WNM1USA | 6206 |
| 270 | 7590 | 06/14/2005 | EXAMINER | |
| HOWSON AND HOWSON ONE SPRING HOUSE CORPORATION CENTER BOX 457 321 NORRISTOWN ROAD SPRING HOUSE, PA 19477 | | | MILLER, DANIEL H | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1775 | |
| DATE MAILED: 06/14/2005 | | | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | | |
|------------------------------|------------------------|--|---------------------|--|
| Office Action Summary | Application No. | | Applicant(s) | |
| | 10/824,275 | | JONES, JAMES P. | |
| | Examiner | | Art Unit | |
| | Daniel Miller | | 1775 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☒ Claim(s) 9 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>4/28/04</u> . | 6) <input type="checkbox"/> Other: ____. |

Claim Objections

Claim 9 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 9 is dependent upon claim 7 but is otherwise identical to claim 7 other than their respective dependencies.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 & 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Foster et al (U.S. 5,104,475).

Foster teaches a carpet using an edge-to-edge relationship held together using a seam made from polyamide hot-melt and fiberglass fibers (see abstract and column 3

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line 1-10). The carpet additionally had a cushioning layer adhesively connected to the floor (column 3 line 50-65). Foster is silent as to being specifically used as an artificial turf, or a polyurethane backing or 140 or 150 degree melt point. It is the examiners interpretation that any polyamide hot-melt of Foster will either necessarily possess a softening point about 140 or 150 degrees C or that the condition is merely an optimization through routine experimentation. It has been held that where the claimed and prior art products are identical or substantially identical in structure or are produced by identical or a substantially identical processes, a *prima facie* case of either anticipation or obviousness will be considered to have been established over functional limitations that stem from the claimed structure. *In re Best*, 195 USPQ 430, 433 (CCPA 1977), *In re Spada*, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990). The ***prima facie*** case can be rebutted by evidence showing that the prior art products do not necessarily possess the characteristics of the claimed products. *In re Best*, 195 USPQ 430, 433 (CCPA 1977). However, Foster is silent as to there being two cushion layers.

It would have been obvious to a person of ordinary skill in the art from Foster to use two cushion layers and the structure of Foster in order to increase cushioning effect.

Claims 2, 4, & 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Foster et al (U.S. 5,104,475) in view of Layman et al (U.S. 4,489,115).

Foster teaches a carpet using an edge-to-edge relationship held together using a seam made from polyamide hot-melt and fiberglass fibers (see abstract and column 3

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line 1-10). The carpet additionally had a cushioning layer adhesively connected to the floor (column 3 line 50-65). Foster is silent as to a polyurethane backing or 140 or 150 degree melt point. It is the examiners interpretation that any polyamide hot-melt of Foster will either necessarily possess a softening point about 140 or 150 degrees C or that the condition is merely an optimization through routine experimentation. It has been held that where the claimed and prior art products are identical or substantially identical in structure or are produced by identical or a substantially identical processes, a prima facie case of either anticipation or obviousness will be considered to have been established over functional limitations that stem from the claimed structure. *In re Best*, 195 USPQ 430, 433 (CCPA 1977), *In re Spada*, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990). The **prima facie** case can be rebutted by evidence showing that the prior art products do not necessarily possess the characteristics of the claimed products. *In re Best*, 195 USPQ 430, 433 (CCPA 1977).

Also, see Burgess (U.S. 3,563,830) that discloses a hot melt that is sufficiently tacky at 200-400 degrees F and hardens at about 120 degrees F (column 3 line 60-70).

Layman teaches an artificial turf having foamed polyurethane backing (or pad). With two pieces being fascines using a hook and loop fascining device. The backing is used to provide dimensional stability and provide shock absorbing (see abstract and column 3 line 1-25).

It would have been obvious to a person of ordinary skill in the art at the time of the invention to combine the carpet of Foster with the turf of Layman to make an outdoor synthetic turf of greater dimensional stability and shock absorption.

Claims 6 and 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Foster et al (U.S. 5,104,475) as applied to claim 1 above, and further in view of Spendlove (U.S. 6043,302).

Foster suggests all the limitations of claim 1 as above but is silent on a cushion backing being made of rubber. It would further be obvious from the disclosures of Foster and Layman that an attached padding or cushion would or could be contemplated to be bonded to an adjacent member using the same means as that used to attach the turf itself.

Spendlove teaches an impact absorbing material made from particulate rubber in a binder used for sports pitches and athletic tracks (abstract). It can be overlayed with a simple sand filled carpet for athletics providing a firm base (column 3 line 1-20). Further, the applicant admits in his specifications background that rubber pads are known in the art.

It would have been obvious to a person of ordinary skill in the art at the time of the invention to substitute the padding of Spendlove in the structure of Foster and Layman because it can be overlayed with a simple sand filled carpet for athletics providing a firm base.

Claims 7 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Foster et al (U.S. 5,104,475) in view of Layman et al (U.S. 4,489,115) in view of

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Spendlove (U.S. 6043,302) as applied to claim 6 above, and further in view of Kocinec et al (PG-PUB 2003/0044563 A1).

Foster further in view of Spendlove teach all the limitations of claims 6 as above but are silent on the tape having a polyester fabric backing.

Kocinec teaches a multi-layered hot melt tape with a polyester fabric backing (see abstract). The tape is useful for creating a waterproof seam and repairs or close any rips, tears, or perforations in a fabric (U.S. 0010, 0017).

It would have been obvious to a person of ordinary skill in the art at the time of the invention to substitute the tape backing of Kocinec with the backing taught by Spendlove to creating a waterproof seam and repair any rips, tears, or perforations in a fabric would also be instantly thought to be used as a seam tape.

Claims 10-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Foster in view of Layman, and further in view of Rose (U.S. 5,082,705).

Foster teaches a carpet using an edge-to-edge relationship held together using a seam made from polyamide hot-melt and fiberglass fibers (see abstract and column 3 line 1-10). The carpet additionally had a cushioning layer adhesively connected to the floor (column 3 line 50-65). Foster is silent as to a polyurethane backing or 140 or 150 degree melt point. It is the examiners interpretation that any polyamide hot-melt of Foster will ether necessarily possess a softening point about 140 or 150 degrees C or that the condition is merely an optimization through routine experimentation. It has been held that where the claimed and prior art products are identical or substantially

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identical in structure or are produced by identical or a substantially identical processes, a *prima facie* case of either anticipation or obviousness will be considered to have been established over functional limitations that stem from the claimed structure. *In re Best*, 195 USPQ 430, 433 (CCPA 1977), *In re Spada*, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990). The ***prima facie*** case can be rebutted by evidence showing that the prior art products do not necessarily possess the characteristics of the claimed products. *In re Best*, 195 USPQ 430, 433 (CCPA 1977).

Also, see Burgess (U.S. 3,563,830) that discloses a hot melt that is sufficiently tacky at 200-400 degrees F and hardens at about 120 degrees F (column 3 line 60-70).

Layman teaches an artificial turf having foamed polyurethane backing (or pad). With two pieces being fascines using a hook and loop fascining device. The backing is used to provide dimensional stability and provide shock absorbing (see abstract and column 3 line 1-25). Layman further discloses a tuft carpet through a fabric backing with a resin coating holding tufts in place (see figure 1).

Rose discloses a carpet underlay that can be made of rubber and that a hot melt adhesive to bond the carpet seam and the carpet to the cushion and the cushion to the floor (column 5 line 55-69). A woven mesh scrim can be attached to the underside of the cushion as well as the top portion (column 4 line 5-10). The examiner is interpreting the language of the column 5 line 20-30 to be affirm the principle that solvent adhesives and hot melts could be used interchangeably. So anywhere that the reference using an adhesive would suggest to a person of ordinary skill in the art to substitute a hot melt. This would accomplish the goal of the invention which is to create a carpet with a carpet

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interlay firmly attached to the floor and each other to avoid wrinkling in heavy foot traffic (column 3 line 40-45).

It is the examiners interpretation that in the process of laying artificial turf in strips that the turf would be in roles of 3 or more edge-to-edge relationship. Further, changing the width of a standard carpet size of in order to fit a specific area is obvious. In *Gardner v. TEC Systems, Inc.*, 725 F2d 1338, 220 USPQ 777 (Fed. Cir. 1984), cert. Denied, 469 U.S. 830, 225 USPQ 232 (1984), the Federal Circuit held that, where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device.

Therefore, as shown in figure 1 and 2, it would have been obvious to a person of ordinary skill in the art at the time of the invention to cover the cushion in a fabric and to make the cushion out of rubber particles in a binder and to use a hot-melt adhesive to bind the cushion and carpet or grass together and close the seam in order to create a carpet with a carpet interlay firmly attached to the floor and each other to avoid wrinkling in heavy foot traffic.

Conclusion

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Cited but not relied upon is Foster et al (U.S. 5,534,575) using a polyamide fiber hot melt with melting point of 149 C (abstract).

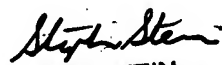
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel Miller whose telephone number is (571) 272-1534. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Deborah Jones can be reached on (571) 272-1535. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Daniel Miller


STEPHEN STEIN
PRIMARY EXAMINER